

REMARKS

The Office Action mailed on February 23, 2009, has been considered. Prior to this paper, claims 1 and 3-13 were pending. By this paper, Applicant does not cancel any claims, and adds claims 14-25. Therefore, claims 1 and 3-25 are now pending.

New claims 14-25 are duplicative of claims 1-12 as originally filed, with the exception that the amendments to those claims made in response to the various allegations of informalities by the USPTO and made on Applicant's own initiative during prosecution of those claims have been incorporated into new claims 14-25. That is, the subject matter scope of new claims 14-25 reflects the subject matter scope of the claim set as pending prior to the usage of Simpson (U.S. Patent Application Publication No. 2004/0161657) to reject the claims.

Applicant respectfully submits that the present application is in condition for allowance for at least the reasons that follow.

Declarations of Tetsuya Kamihara (Applicant) and Yoji Ito

By this paper, Applicant Mr. Tetsuya Kamihara provides his declaration, in Appendix I, detailing that by at least November 26, 2002, he had invented the invention covered by claims 1 and 3-25 presented above.

Appendix II presents the declaration of Mr. Yoji Ito, who is fluent in the written English Language and the written Japanese language. In his declaration, Mr. Yoji Ito details that the English language translation (Exhibit I of Mr. Yoji Ito's declaration) of the draft patent application (Exhibit B in Mr. Tetsuya Kamihara's declaration, Exhibit II in Mr. Yoji Ito's declaration) referenced by Mr. Tetsuya Kamihara is accurate.

Rejections Under 35 U.S.C. § 103

Claims 1 and 3-13,¹ stand rejected under 35 U.S.C. § 103 as being anticipated by Simpson (U.S. Patent Application Publication No. 2004/0161657). **Simpson is not prior art against any claim now pending.** Specifically, because a reference must be prior art under 35 U.S.C. § 102 to be usable under 35 U.S.C. § 103, Simpson renders no claim obvious.

§ 102(b): Simpson is not prior art under 35 U.S.C. § 102(b), because it was published on August 19, 2004, and the present application was filed as a PCT application designating the United States on December 03, 2003, and entered the national stage in the United States on December 29, 2004.

§§ 102(a) and (e): Simpson is not prior art under 35 U.S.C. § 102(a) or under 35 U.S.C. § 102(e), because Applicant Tetsuya Kamihara invented the inventions covered by claims 1 and 3-25 above by at least November 26, 2002, as is detailed in his declaration presented in Appendix I.

§§ 102(c), (d), (f) and (g): It is respectfully submitted that the rejections formulated in the outstanding Office Action are not applicable to rejections under 35 U.S.C. §§ 102(c), (d), (f) or (g).

* * * * *

In view of the fact that Simpson is not prior art to any of the pending claims, it is respectfully submitted that the previously presented rejections relying on Simpson are now moot.

Allowance of the claims is requested.

* * * * *

¹ Claim 13 is indicated as being rejected on page 3 of the Office Action, yet on page 2 of the Office Action, the Office only identifies claims 1 and 3-12 as being rejected, with no claims being withdrawn. Claim 13 is not referenced in the text

Applicant withdraws all prior arguments regarding the patentability of the claims in view of the teachings of Simpson, including all prior arguments regarding the scope of the claims, and all prior arguments regarding the teachings of Simpson.

Statement in the Office Action Regarding “Specification”

The Office Action alleges that the title “is not descriptive.” Applicant respectfully submits that the title is descriptive, as Applicant claims a fuel cell. Also, the Office Action does not explain exactly why the title “is not descriptive,” and cites no controlling legal authority (statute, regulation, case law), Board of Appeals precedent, or even MPEP guideline, to support the allegation. Indeed, the assertion is all but opposite the mandate of 37 CFR §1.72 (see also MPEP §606), which states that the title “must be as short and specific as possible.” (Emphasis added.)

In order to advance prosecution, *Applicant will entertain a proposal from the USPTO regarding a new title.*

Conclusion

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Examiner Suitte is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date 5/15/2009

By 

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 295-4747
Facsimile: (202) 672-5399

Martin J. Cosenza
Attorney for Applicants
Registration No. 48,892